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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,648	03/01/2000	Roger P Hoffman	P/2-61	3239

7590

09/25/2002

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 09/25/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

Office Action Summary	Application No.	Applicant(s)	
	09/516,648	HOFFMAN, ROGER P	
	Examiner	Art Unit	
	Kevin R Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "high quality graphics" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning. Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.
2. The rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by amendment. Applicant has support for the limitation "thicker" on page 9, line 1 of the specification.
3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "enhanced smoothness" is a relative term and it is unclear with respect to what the smoothness is "enhanced." The original disclosure provides no guidance to one of ordinary skill in the art on how the term should be interpreted.

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4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "publication grade paper" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning.

Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "lable stock grade" is indefinite. The term is not defined in the specification, nor does the term have an art accepted meaning. Applicant must amend the claim, show where the term is defined in the original disclosure, or provide the Office with a reference that defines the term and predates the prior date of the current Application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173) for reasons of record.

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2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4 and 6-13, for reasons of record.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4 and 6-13, for reasons of record.

4. Claims 15-19 are rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4 and 6-13, and further in view of Confer (US 3,603,501), for reasons of record.

5. Claims 15-19 are rejected under Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4 and 6-13, and further in view of Hall (US 4,441,626) for reasons of record.

6. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cavagna et al. (US 4,898,752) in view of Peer et al. (US 4,254,173), as applied to claims 1-4 and 6-13 above, and further in view of Knudson et al. (US 4,913,773) for reasons of record.

Response to Arguments

Applicant's arguments filed July 8, 2002 have been fully considered but they are not persuasive.

Applicant argues that the term "high quality graphics" is a term of the art. In support of this position, Applicant cites the use of the term in Cavagna. However, Cavagna fails to define the term "high quality graphic." Applicant also failed to supply

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the office with a reference that defines the term and predates the priority date of the current Application. Thus, Applicant's arguments fail to overcome the outstanding 112, second paragraph rejection.

Applicant similarly argues that the term "label stock grade" is an art accepted term, but fails to provide support for such a conclusion.

The 35 U.S.C. 112, second paragraph rejection on the term "enhanced smoothness" has been maintained. Applicant argues that the term is defined on page 6 of the specification. However, the disclosure on page 6 does not constitute a definition. Specifically, the disclosure of page 6 does not clearly define the term by explaining to one of ordinary skill in the art how to determine when a product exhibits "enhanced smoothness."

The 35 U.S.C. 112, second paragraph rejection on the term "publication grade paper" has also been maintained. Applicant points to the disclosure on pages 5 and 11 of the specification. However, the disclosure on neither page renders the term definite. Specifically, the disclosure on pages 5 and 11 give examples of publication grade paper, but does not define the term in such a way that one of ordinary skill in the art would clearly understand the metes and bounds of the term.

With respect to the rejections based upon Cavagna in view of Peer, Applicant argues that Cavagna does not teach a two-ply base comprised of a bottom ply of unbleached cellulosic fiber and a top ply comprised of bleached or brightened cellulosic fibers. The examiner respectfully disagrees. Cavagna teaches an unbleached paperboard (col 1, line 15) coated with a high quality label paper (col 1, line 25).

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Applicant also argues that claim 1 requires "enhanced smoothness." However, said term is indefinite. However, since the top layer of Cavagna is printable col 1, line 21) and Applicant indicates that layers exhibiting "enhanced smoothness" are printable (see page 6, second paragraph), the examiner takes the position that said limitation has been met.

Thus, Applicant's arguments are not persuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:00 a.m. to 4:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

KRK

KRK

Paul Thibodeau

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700